

Serial No. 09/214,971

Amendment Dated: July 6, 2005

In response to Office Action Dated June 7, 2005

PATENT

Docket No. 58009-011900

### REMARKS

The Applicants would like to thank the Examiner for the personal interview conducted on March 14, 2005. In accordance with MPEP 713.04, the substance of the interview on March 14, 2005, concerned the term regenerated leather. Applicants believe the term means scraps of mostly natural leather. However, the Examiner had expressed concerns about support of the definition in the specification. However, Applicants' representative pointed out that the specification did also have support for the term "Salpa." The Examiner noted that relying on the supported term Salpa would be the best route for the Applicants. Reconsideration of the above application is respectfully requested.

### Claim Amendments and New Claims

The Applicants have amended Claims 8, 13, and 18. In particular, Applicants have clarified the material as scraps of natural leather. The Applicants have amended Claims 31, 32, and 33. Specifically, Applicants have replaced the term reconstructed leather with "regenerated leather." No new matter has been added.

### Claim Rejections - 35 - U.S.C. § 112

Examiner has rejected Claims 8, 9, 24-31 under 35 U.S.C. § 112, first paragraph. The Examiner asserts that the claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claims in the invention. In particular, the Examiner asserts that Claims 8 and 31, which contain the phrase "to provide a composite with only two materials," are not supported in the specification and thus, is new matter.

However, the specification clearly provides for composite material constituting of two materials and is not new matter. In particular, the specification as-filed in page 3, lines 12-15 states, "According to the present invention, the composite material is constituted by a suitable supporting material, available in sheets or rolls, to which a polyethylene or Surlyn® covering layer is applied, said covering layer being advantageously constituted by a thin film." In other words, the specification clearly defines a composite material made of two materials: (i) a suitable

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supporting material and (ii) a thin film of polyethylene or Surllyn® which covers the supporting material. Therefore the phrase "to provide a composite with only two materials" as recited in Claims 8 and 31 is fully supported in the specification and is not new matter. Accordingly, Applicants respectfully request the Examiner to withdraw these rejections as to Claims 8 and 31.

The Examiner has also rejected Claims 8, 9, 13, 14, 18, 19, and 24-36 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Examiner asserts that Claims 8, 13, 18, 31, 32 and 33 are unclear. Accordingly, Applicants have amended these claims. Thus, Applicants respectfully request the Examiner to withdraw these rejections as to Claims 8, 9, 13, 14, 18, 19, and 24-36.

#### Claim Rejections - 35 – U.S.C. § 102

##### **Hirsch**

Examiner has rejected Claims 8, 9, 13, 14, 18, 19, 24-27, 30, 32, and 33 under 35 U.S.C. 102(b) as being anticipated by Hirsch (U.S. Patent No. 4,849,145). However, Hirsch fails to disclose all the elements of the newly amended, independent Claims 8, 13, 18, 31, and 33. The Federal Circuit states that "all elements of the claimed invention must be disclosed in a single reference for anticipation to exist." Atlas Powder Co. v. E. I. DuPont de Nemours & Co., 750 F.2d 1569, 224 U.S.P.Q 409 (Fed. Cir. 1984). Furthermore, missing elements cannot be supplied by the knowledge of one skilled in the art or the disclosure of another reference in order to give rise to an anticipation rejection. Structural Rubber Products Co. v. Park Rubber Co., 749 F.2d 707, 223 U.S.P.Q 1264 (Fed. Cir. 1984).

All of the elements of newly amended independent Claims 8, 13, 18, 30, 32, and 33 are not found in the Hirsch reference. With regard to Claims 8, 13, 18, and 30, the Examiner asserts that Hirsch discloses a method of using a composite material comprising a supporting material in the form of a sheet or roll constituted by and cover a covering later including a film of polyethylene to provide a composite materials of only two materials, the materials being natural leather and polyethylene film. However, Hirsch fails to disclose a composite material in which the supporting material is made from scraps of natural leather as recited in newly amended

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Claims 8, 13, 18, and dependent Claim 30. In particular, Hirsch discloses using a single strip of natural leather. This strip is not made from scraps of natural leather and is in fact only one single piece of leather as depicted in Figures 1, 9, 10, 12 and 15. This is apposite from a material which is made mostly from scraps (prices, shards, fibers) of natural leather. Thus, Hirsch fails to teach all the elements of newly amended Claims 8, 13, 18, and dependent Claim 30. In addition, Hirsch fails to disclose the elements of their corresponding dependent claims. Therefore, there is no anticipation of Claims 8, 13, 18, and 30 by Hirsch.

Furthermore, the specification of the above-identified application fully supports a supporting material made from scraps of natural leather. Specifically, at page 3, lines 12-22, the specification as-filed states that "the supporting material is constituted by...leather regenerated materials of derivatives thereof (for instance Salpa)." Salpa is a trade name for regenerated leather. This is supported by the official trademark filing for the term "Salpa," attached as Exhibit A. The goods and services list Salpa as "material made from scraps of real leather from which may be manufactured various articles." Thus, the specification discloses and fully supports a supporting material made from scraps of natural leather.

With regard to newly amended independent Claims 32 and 33, the Examiner asserts that Hirsch discloses all the elements of these Claims. However, Hirsch fails to disclose a composite where the supporting material is made from regenerated leather. The Examiner herself has stated in page 22, last paragraph, of the office action that "Hirsch fails to disclose the supporting material is constituted of a mixture of regenerated natural leather material." Both Claims 32 and 33 recite using regenerated leather as the supporting material. Furthermore, the specification fully supports the use of regenerated leather as a supporting material. As stated above, page 3, lines 12-22, of the specification as-filed states that "the supporting material is constituted by...leather regenerated materials of derivatives thereof (for instance Salpa)" and Salpa is the trade name for regenerated leather. Thus, because Hirsch fails to disclose all the elements of newly amended Claims 32 and 33, Hirsch does not anticipate Claims 32 and 33 or their corresponding dependent claims.

In light of these amendments and arguments, Applicants have overcome the Examiner's 35 U.S.C. § 102(b) rejections with respect to Hirsch. Thus, the Examiner is respectfully

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requested to withdraw these rejections with respect to Claims 8, 9, 13, 14, 18, 19, 24-27, 30, 32, and 33.

### **Hofferbert & Sutton**

Examiner has rejected Claims 8, 9, 13, 14, 18, 19, 24-27, 32, and 33 under 35 U.S.C. 102(b) as being anticipated by Hofferbert and also anticipated by Sutton. However, Hofferbert and Sutton both fail to disclose all the elements of newly amended, independent Claims 8, 13, 18, 32, and 33 for the same reasons Hirsch does anticipate these claims. Specifically, both Hofferbert and Sutton do not disclose a composite where the supporting material is made of scraps of natural leather as recited in Claims 8, 9, 13, 14, 18, and 19. Additionally, both Hofferbert and Sutton do not disclose a composition where the supporting material is made of regenerated leather as recited in Claims 32 and 33. Thus, for the same reasons as stated above, both Hofferbert and Sutton fail to anticipate newly amended, independent Claims 8, 13, 18, 32, and 33 and their corresponding dependent claims. In light of these amendments and arguments, Applicants have overcome the Examiner's 35 U.S.C. § 102(b)-rejections with respect to Hofferbert and Sutton. Thus, the Examiner is respectfully requested to withdraw these rejections with respect to Claims 8, 9, 13, 14, 18, 19, 24-27, 32, and 33.

### **Claim Rejections - 35 – U.S.C. § 103(a)**

#### **Hirsch in view of Parrini**

Examiner has rejected Claims 31-33 under 35 U.S.C. 103(a) as being unpatentable over Hirsch in view of Parrini. Examiner asserts that Hirsch discloses all the elements of independent Claims 31-33 except that Hirsch fails to disclose a supporting material made from regenerated leather, but that Parrini discloses a material mixture comprising of leather fiber. Thus, it would have been obvious to one of ordinary skill in the art to combine the leather fiber mixture found in Parrini with the leather material disclosed in Hirsch. However, the Hirsch and Parrini references when combined do not teach all the elements of the newly amended independent Claims 31-33.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580

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(CCPA 1974). See also, MPEP 2143.03. Specifically, the Hirsch and Parrini references, when combined, do not teach a composite where the supporting material is regenerated leather as recited in Claims 31-33. In particular, Parrini does not disclose regenerated leather that is made of scraps of real leather. Instead, Parrini discloses a mixture of (a) 30-60% leather fibers, (b) 35-65% of fibrils or synthetic polymers and (c) 5-15% of cellulose fibers. Clearly, this mixture is not the same as regenerated leather. Thus, combining the Parrini mixture with the Hirsch disclosure does not create the composite recited in Claims 31-33. Accordingly, Parrini in combination with Hirsch does not render Claims 31-33 obvious, and Applicants respectfully request that the Examiner also withdraw these rejections as to Claims 31-33.

#### **Hirsch in view of Parrini in further view of Hara**

The Examiner has rejected Claims 34-36 under 35 U.S.C. 103(a) as being unpatentable over Hirsch in view of Parrini in further view of Hara. Claims 34-36 depend from Claims 31-33. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending there from is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also, MPEP 2143.03. Thus, for the same reasons as stated above, Hirsch in combination with Parrini and in further combination with Hara does not render Claims 31-33 obvious or its corresponding dependent claims 34-36 obvious. This combination simply does not teach all the elements of these claims. As stated above, Hirsch in combination with Parrini does not render claims 31-33 obvious, and further combining with Hara still does not render its dependent claims obvious. Therefore, Claims 34-36 are not rendered obvious by Hirsch in view of Parrini in further view of Hara. Accordingly, Applicants respectfully request that the Examiner also withdraw these rejections as to Claims 34-36.

#### **Hirsch in view of Nishumure**

The Examiner also relies on Hirsch in combination with Nishumure to reject Claim 28. Again, Hirsch does not disclose all the elements of Claim 28. In particular, Hirsch does not disclose scraps of natural leather. Thus, alone or in combination with Nishumure, Hirsch does not render Claim 28 obvious. Accordingly, Applicants respectfully request that the Examiner also withdraw these rejections as to Claim 28.

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#### **Hofferbert in view of Nishumure**

The Examiner relies on Hofferbert in view of Nishumure to reject Claim 28. The combination of Hofferbert and Nishumure does not disclose all the elements of Claim 28 and thus cannot render Claim 28 obvious. Specifically, the Hofferbert and Nishumure references when combined do not teach a composite where the supporting material is scraps of natural leather. In particular, Hofferbert does not disclose a supporting material made from scraps of natural leather. Nishumure does not supply this missing element. Thus, when combined, Hofferbert and Nishumure do not disclose all the elements of Claim 28 and thus cannot render Claim 28 obvious. Accordingly, Applicants respectfully request that the Examiner also withdraw these rejections as to Claim 28.

#### **Sutton in view of Nishumure**

The Examiner relies on Sutton in view of Nishumure to reject Claim 28. The combination of Sutton and Nishumure does not disclose all the elements of Claim 28 and thus cannot render Claim 28 obvious. Specifically, the Sutton and Nishumure references when combined do not teach a composite where the supporting material is scraps of natural leather. In particular, Sutton does not disclose a supporting material made from scraps of natural leather. Nishumure does not supply this missing element. Thus, when combined, Sutton and Nishumure do not disclose all the elements of Claim 28 and thus cannot render Claim 28 obvious. Accordingly, Applicants respectfully requests that the Examiner also withdraw these rejections as to Claim 28.

#### **Hirsch in view of Hara**

Furthermore, the Examiner relies on Hirsch in combination with Hara to reject Claim 29. As with Claim 28, Hirsch does not disclose the element of scraps of natural leather. Thus, alone or in combination with Hara, Hirsch does not render Claim 29 obvious. Accordingly, Applicants respectfully request that the Examiner also withdraw these rejections as to Claim 29.

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### **Hofferbert in view of Hara**

The Examiner relies on Hofferbert in view of Hara to reject Claim 29. The combination of Hofferbert and Hara does not disclose all the elements of Claim 29 and thus cannot render Claim 29 obvious. Specifically, the Hofferbert and Hara references when combined do not teach a composite where the supporting material is scraps of natural leather. In particular, Hofferbert does not disclose a supporting material made from scraps of natural leather. Hara does not supply this missing element. Thus, when combined, Hofferbert and Hara do not disclose all the elements of Claim 29 and thus cannot render Claim 29 obvious. Accordingly, Applicants respectfully request that the Examiner also withdraw these rejections as to Claim 29.

### **Sutton in view of Hara**

The Examiner relies on Sutton in view of Hara to reject Claim 29. The combination of Sutton and Hara does not disclose all the elements of Claim 29 and thus cannot render Claim 29 obvious. Specifically, the Sutton and Hara references when combined do not teach a composite where the supporting material is scraps of natural leather. In particular, Sutton does not disclose a supporting material made from scraps of natural leather. Hara does not supply this missing element. Thus, when combined, Sutton and Hara do not disclose all the elements of Claim 29 and thus cannot render Claim 29 obvious. Accordingly, Applicants respectfully request that the Examiner also withdraw these rejections as to Claim 29.

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Conclusion

In view of the above, it is submitted that this application is now in good order for allowance, and such early action is respectfully solicited. Should matters remain which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney.

This response is being timely filed and no fee is believed due. However, if Applicant is mistaken, the Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number 58009-011900 is referred to when charging any payments or credits for this case.

Respectfully submitted,

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